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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,539	07/01/2003	Bansi Lal	516745-2001.1	4710
7590 11/04/2005				
FROMMER LAWRENCE & HAUG LLP		EXAMINER		
745 Fifth Avenue		SACKEY, EBENEZER O		
New York, NY 10151		ART UNIT PAPER NUMBER		

1626

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/611,539	Applicant(s) LAL ET AL.	
	Examiner EBENEZER SACKY	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 6 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 12 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-23 are pending.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Information Disclosure Statement filed on 05/13/04 is acknowledged and has been entered into the file. A signed copy of the 1449 is attached herewith.

Response to Restriction

Applicant's election with traverse of Group I, claims 1-13 and species of Example 11, ((+)-*trans*-2-(2-chlorophenyl)5,7-dihydroxy-8-(2-hydroxymethyl-1-methyl-pyrrolidin-3-yl)-chromen-4-one in the reply filed on 08/04/05 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that searching the entire application would represent a serious burden on the office. This is not found persuasive because contrary to applicants assertion, searching the entire application would constitute a serious burden because for example, the various "A" moieties i.e., the 5 or 6 membered hetero and nonhetero rings are variously classified not to mention all the various substituents on the basic chromene core and combinations thereof do constitute an undue burden. Additionally, the wide disparity among the various subgroups requires that many divergent fields must be searched, including but not 548, 560 etc. Thus, the vast number of theoretically conceivable compounds comprised under formula (I) of claim 1 again constitutes an undue burden on the Examiner.

The generic concept being examined with respect to the elected species is as follows: Z is O or S, R₁ is as defined, R₂ is as defined, R₃ is as defined, R₄ is as defined, R₅ is as defined, R₆ is as defined, A is 5-membered rings (i)-(v), where X₁ and X₂ is carbon and nitrogen.

Applicants should note compounds, which do not fall under the generic concept are species in claim 11:

Page 168, the 5th and 6th species,

Page 169, the 5th and 6th species,

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Page 170, the last species and

Page 171, the first species.

Claims 14-23 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to non-elected subject matter.

Claims 5 and 7-10 contains non-elected subject matter.

The above-mentioned withdrawn compounds that are withdrawn from consideration as being drawn to non-elected subject matter differ materially in structure and composition from the compounds of the elected invention.

The withdrawn subject matter is properly restricted as it differs materially in structure and element from the elected subject matter identified *supra* so as to be patentably distinct therefrom. A reference, which anticipates the elected subject matter, would not even render obvious the non-elected subject matter. Accordingly, the restriction as required is proper.

The requirement is thus deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

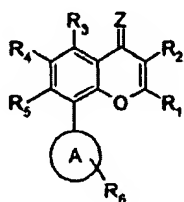
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gross et al., A Stereocontrolled approach to substituted piperidones and piperidines:

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flavopiridol D-ring analogs, Tetrahedron Letters 42, (2001) pp. 1631-1633, and Mansuri et al., (U.S. Patent number 5,733,920)('920').

Applicants claim compounds and compositions containing compounds of structural formula (I), where the substituents are as defined in claim 1.



1. Gross et al., discloses compounds, compositions containing compounds of structural formula (I), which anticipate the instant compounds. See page 1631 and compound number 10 on page 1632.

2. Also see '920' column 30, lines 50-61, compound number 3, column 39, compound number 3.

Allowable Subject Matter

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4 and 6 are allowed over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (571) 272-0704.

The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Joseph K. McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

EOS
October 28, 2005

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER

for

Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1600
Technology Center 1

Kamal Saeed